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REMARKS

The Office Action of November 5, 2003 has been carefully considered. Reconsideration of this application, as amended, is respectfully requested.

Claims 1, 7, 10, and 17 have been amended to further clarify that the entire substrate is compressed in accordance with the claimed invention.

Turning now, to the office action, claims 1-5, 7-8, 10-12 and 17-22 were rejected under 35 USC §103(a) as being unpatentable over US 5,887,408 to Wagner et al. (Wagner) in view of US 3,652,281 to Bachelder et al. (Bachelder). Claim 6 was rejected under 35 USC §103(a) as unpatentable over Wagner in view of US 6,100,804 to Brady et al. (Brady). Claims 8 and 16 was rejected under 35 USC §103(a) as unpatentable over Wagner in view of Bachelder and further in view of Morikawa (US 5,854,957). Claim 9 was rejected under 35 USC §103(a) as unpatentable over Wagner in view of Bachelder and Morikawa and further in view of US 5,925,446 to Matsuda et al. (Matsuda). Claims 13 – 14 were rejected under 35 USC §103(a) as unpatentable over Wagner in view of Bachelder and Morikawa and further in view of US 5,287,150 to Kinoshita et al. (Kinoshita). Claim 15 was rejected under 35 USC §103(a) as unpatentable over Wagner in view of Bachelder and Morikawa and further in view of Kinoshita and Matsuda.

The disclosures of the cited art and the distinctions between the rejected claims may be briefly summarized as follows:

Turning to the first rejection, claims 1-5, 7-8, 10-12 and 17-22 were rejected as unpatentable over Wagner in view of Bachelder. The teachings of Wagner are asserted as disclosing a method for the reduction of the thickness of a compressible substrate bearing an image to preclude the substrate from returning to its initial thickness after compression. Although Applicants acknowledge that the teachings of Wagner do indeed suggest the application of a compressive force, the compression is applied to a plurality of sheets and is ONLY applied to the edges of such sheets. Indeed, Wagner specifically teaches away from the application of a compressive force to an entire substrate as it only seeks to activate pressure sensitive adhesives along the edges of envelope sheets, not the sheets enclosed therein. Furthermore, in spite of the Examiner's citation to a lengthy section of the Wagner patent disclosure (col. 4, line 51 to col. 6, line 33)

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Applicants are at a loss to determine where, in the cited text, the Wagner patent teaches or even suggests that the thickness of even the compressed envelope edges is precluded from returning to an initial thickness. The Examiner, it seems, has mistakenly applied a teaching of rollers to activate a pressure sensitive adhesive along a sheet edge by Wagner, to conclude that the thickness of the substrate is permanently reduced. Furthermore, the present independent claims have been amended to clarify that the entire substrate is reduced in thickness. Accordingly, the claims of the present application are clearly distinguishable over Wagner.

The Examiner has, correctly, noted that Wagner does not teach or suggest the application of heat, and seeks to combine the teachings of Wagner with Bachelder. First, Applicant wishes to note, for the Examiner's further consideration, that claim 17 does not recite a heat limitation, thus there is ambiguity as to whether the rejection of claim 17, under the combination of Wagner and Bachelder, is appropriate. Applicant respectfully reserves the opportunity to respond to any subsequent rejection of claim 17 in the event that it is not allowed in light of the amendment and arguments set forth herein.

Second, with respect to the teachings of Bachelder, it again appears that the Examiner has taken liberty relative to establishing a proper basis for combining the teachings of Wagner and Bachelder. Bachelder is directed to conventional "Polaroid" film manufacturing, and the superposition of spacing strips and an advancing sheet between a pair of "heat-sealing rolls 82." (col. 12, lines 37-39) Again, it appears that the relied-upon reference is directed to an adhesive operation. No mention of a substrate thickness, before or after heat sealing with rolls, is identified by Applicants. Accordingly, one can only conclude that the limitations of independent claims 1, 7, 10, 17 and 21, are patentably distinguishable over Bachelder.

Lastly, the Examiner has failed to establish *prima facie* obviousness. More specifically, the rejection fails to set forth any teaching or suggestion of the motivation to combine a confidential facsimile system (Wagner) and a film processing method (Bachelder) as has been suggested by the present rejection. Rather, it again appears that the Examiner has employed the claim limitations of the present application as a "recipe" by which a piecemeal construction or combination has been attempted. As was previously noted to the Examiner in the

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Applicants' last response, a piecemeal reconstruction of the prior art patents in light of Appellant's disclosure is not a basis for a holding of obviousness, *In re Kamm et al.*, 172 USPQ 298 (CCPA, 1972). For this reason alone, Applicant's respectfully urge that the Examiner has failed to establish a *prima facie* case of obviousness that can be appropriately addressed. Furthermore, Applicants assert that Wagner specifically teaches away from the use of heat in its selection of pressure seals by stating that "pressure seal cohesives may be applied to envelope sheets without concern that the cohesives will activate due to dampness or heat applied to the sheets prior to their assembly as envelopes." (col. 3, lines 11-17). Hence, Wagner specifically contemplated heat seals and indicated that they were unacceptable. Again, this is an indication that Wagner is not properly combined with Bachelder, and that a *prima facie* basis for the rejection, therefore, has not been established.

Insofar as dependent claims 2-5, 8, 11-12, 18-20 and 22, inclusive, are concerned, these claims all depend from the now presumably allowable independent claims and are also believed to be in allowable condition for the reasons hereinbefore discussed with regard to independent claims 1, 7, 10, 17 and 21. With respect to the remaining dependent claims (2-5, 8, 11-12, 18-20 and 22), the Applicants, for the sake of brevity, will not address the reasons supporting patentability for each of these individual dependent claims, as these claims depend directly from the presumably allowable independent claims for the reasons set forth above. Applicants reserve the right to address the patentability of each of these dependent claims at a later time, should it be necessary.

Claim 6 was rejected under 35 USC §103(a) as unpatentable over Wagner in view of US 6,100,804 to Brady et al. (Brady). With respect to the distinctions over the teachings of Wagner, Applicants respectfully urge and incorporate herein the distinctions noted above relative to claim 1 from which claim 6 depends. With respect to Brady, the patent suggests "thermal compression" as one of a number of bonding techniques that may be used to connect various components of the RFID tag disclosed therein. However, as pointed out by Applicants in response to the previous Office Action, the context of the citation at the top of col. 8 is directed entirely to electrical contact bonding techniques. Brady does discuss the "thinning" of the RFID device at columns 3 and 7, but the thinning operation is clearly taught at col. 3 to be accomplished by polishing or back grinding the wafer

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(semiconductor). There appears to be no suggestion or teaching by Brady to the thinning of a substrate with markings thereon by compression. Moreover, such an interpretation is taught away from by Brady at col. 6, lines 41-45, where it clearly states that positioning of the RFID tag in an area that is not printed is preferable, "since the force of the print head against the label could potentially damage the RFID tag." (emphasis added) Hence, Applicants respectfully submit that Brady not only does not teach the application of a compressive force to reduce the thickness of a substrate, but specifically teaches away from such a process by suggesting that the application of force is potentially damaging. Accordingly, claim 6 is believed to be patentably distinguishable over Brady, either alone or in combination with Wagner.

Furthermore, Applicants are, once again, at a loss to understand what motivation the Examiner has relied upon for the proposed combination of Wagner in view of Brady. There does not appear to be a cogent reason, teaching or even the slightest suggestion of the combination of Brady to modify the teachings of Wagner. Absent a teaching or suggestion of such a combination, Applicants respectfully submit that the conclusory statement set forth as the basis for the combination is unsupported by the references themselves, and that *prima facie* obviousness has not been established. Hence, claim 6 is in condition for allowance.

With respect to the rejection of claim 8 as unpatentable over Wagner in view of Bachelder and further in view of Morikawa, Applicants are confused as to the basis for this rejection. In setting forth the claim rejections the Examiner, on one hand, indicates what is not taught by Wagner, yet claim 8 was previously rejected under §103(a) over Wagner in view of Bachelder. In the present rejection of claim 8, which is directed to a substrate containing an image produced using a **toner deposition** process, the Examiner relies upon the additional teachings of Morikawa — presumably to teach that which is not set forth by Wagner or Bachelder, and leading to the conclusion that the prior rejection of claim 8 was in error!

Applicants respectfully incorporate herein the previously identified distinctions and failure of the rejection of claim 7, from which claim 8 depends. The Examiner has relied upon Morikawa to bolster the improper combination of Wagner and Bachelder through its teaching of a thermal fixing unit. Morikawa is generally

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directed to an image formation apparatus having an apparatus for fixing toner images (fixing device 84) to a sheet (col. 5, lines 45-65). Morikawa fails to teach or even suggest the concurrent application of a compressive force as set forth in claim 7 (to compress the entire substrate) and heating of the substrate to produce an improved glossy image quality. Here again, the Examiner has employed conclusory statements to justify this combination of unrelated patents. In the event the rejection is maintained, Applicants respectfully request that the Examiner indicate where the suggestion for such a combination is taught by any of the patents.

With regard to claim 16, the Examiner has, in spite of Applicants prior response on the matter, once again erroneously interpreted a claim limitation for a stripper finger (see specification page 13, lines 3 – 9) as being equivalent to a gate or switching claw (Morikawa switching claw 601) that is switched, by a solenoid, to control the direction of sheet travel for binding. It is not at all apparent how the switching claw described could operate on the roller, as recited in claim 16, yet be a significant distance from any roller as it is clearly depicted in Morikawa. Again, the Examiner appears to have employed the instant application as the recipe from which to select and/or modify unrelated components of the cited patents in an attempt to reconstruct Applicants' invention. Absent specific teachings on point, claim 16 is once again respectfully urged to be in condition for allowance.

Claim 9 was rejected under 35 USC §103(a) as unpatentable over Wagner in view of Bachelder and Morikawa and further in view of Matsuda. Applicants incorporate herein the previously noted traversal of the related rejections and proposed combination of Wagner in view of Bachelder and Morikawa. To the prior combination, the Examiner has added the teaching of Matsuda, wherein the description of the background of Matsuda refers to two publications that suggest the use of a release agent in the formation of full-color duplex images. The reference is relied upon as suggesting that a release agent may be used during the compression operation cited in the instant application. However, like the other patents cited, Matsuda also fails to teach or suggest the compression of substrates so as to provide a permanent reduction in the thickness of an entire substrate. At most the addition of Matsuda merely suggests the use of a release agent in combination with the recited Morikawa fixing operation. This, however,

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does not give rise to a teaching of the elements of claim 9, nor of claims 7 and 8 from which it depends.

Furthermore, the context of the section of Matsuda relied upon by the Examiner suggests that release agents are undesirable and are removed by transfer paper to avoid "image stain" (col. 4, lines 31-33). Hence Matsuda, considered in context, would appear to teach away from the proposed use set forth by the Examiner in the combination of the patents. Accordingly, Applicants respectfully contend that claim 9 is patentably distinguishable over Wagner in view of Bachelder and Morikawa and further in view of Matsuda, either alone or in combination.

Claims 13 – 14 were rejected under 35 USC §103(a) as unpatentable over Wagner in view of Bachelder and Morikawa and further in view of Kinoshita. Applicants incorporate the arguments set forth above in relation to traversal of the rejection of claims 10 and 11. As noted by the Examiner, claims 13 and 14 add the further limitations of a resilient outer surface (claim 13) and an aluminum roller with an anodized surface (claim 14).

The Examiner has added to the arguable combination of Wagner, Bachelder and Morikawa by relying on the teachings of Kinoshita. Kinoshita teaches a developing device, wherein a resilient roller disposed within a toner housing is employed to peel off toner remaining on the developing sleeve and supply new toner (col. 5, lines 5-8). The resilient roller is described as being formed of a metal core (aluminum) of approximately 5 mm diameter and a silicone rubber foam with a thickness of approximately 5mm on the surface thereof. Not only is the described roller designed to operate in a developer (versus the fixing system of Morikawa), but it is inconceivable just how the roller, with a thick, foam surface, would operate to provide the compressive forces cited in the application. Here again, the Examiner appears to have misconstrued the teachings of the patent in a manner so as to "create" a teaching of elements recited by the present application, without any such suggestion or teaching of such a combination or modification. Put more simply, teaching of a foam surface to prevent toner grains from penetrating the roller is not the same as a resilient outer surface that compensates for unevenness in the rollers. Accordingly, Applicants respectfully urge that not only is the combination improper (not supported by the teachings of the patents themselves), but it does not give rise to adequate teaching on which

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to base a rejection. At most, the addition of Kinoshita leads to the addition or modification of a developer in the Morikawa apparatus. Accordingly, Applicants urge that claims 13 and 14 remain patentably distinguishable over the references of record, either alone or in combination.

Claim 15 was rejected under 35 USC §103(a) as unpatentable over Wagner in view of Bachelder and Morikawa and further in view of Kinoshita and Matsuda. Again, Applicants respectfully submit, and incorporate herein, the traversals noted above relative to the combination of Wagner in view of Bachelder and the additional references relied upon for this rejection. To the previous combination, the Examiner has again added the teachings of Matsuda with respect to a release agent. Once again, the reference to a release agent is only included as a background reference, and is made in combination with the statement that the agent must be removed by transfer paper in order to avoid image stain. At most, Matsuda adds the teaching of the use of a release agent in the developing or fixing stages. Such a teaching does not give rise to the claimed invention, where the rollers are used to apply a compressive force and at least one roller is formed from an anodized aluminum and includes a urethane coating thereover. The urethane coating is not believed to be anticipated by the suggestion of a release agent in Matsuda. Nor is such a combination suggested by any of the other references made of record, either alone or in combination. Hence, Applicants respectfully maintain that claim 15 is patentably distinguishable over Wagner in view of Bachelder and Morikawa and further in view of Kinoshita and Matsuda, either alone or in combination.

Insofar as claims 1 through 22, inclusive, are concerned, these claims are believed to be in allowable condition for the reasons hereinbefore set forth. **Applicants respectfully request immediate attention to this response to a second, non-final action and the timely allowance of the claims set forth herein.**

In view of the foregoing remarks and amendments, reconsideration of this application and allowance thereof are earnestly solicited. In the event that additional fees are required as a result of this response, including fees for extensions of time, such fees should be charged to USPTO Deposit Account No. 50-1706 for Basch & Nickerson LLP.

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In the event the Examiner considers personal contact advantageous to the timely disposition of this case, the Examiner is hereby authorized to call Applicant's attorney, Duane C. Basch, at Telephone Number (585) 899-3970, Penfield, New York.

Respectfully submitted,



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